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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,845	10/24/2005	Thilo Dollase	101769-304-WCG	1571
27386 7590 05/14/2008 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
MULLS, JEFFREY C				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
05/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,845

**Applicant(s)**

DOLLASE ET AL.

**Examiner**

Jeffrey C. Mullis

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 4-7-05/5-10-05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants "softening temperature" in that the softening temperature is defined at paragraph 27 of applicants published specification as the glass transition temperature in the case of amorphous systems and melting temperature in the case of semicrystalline polymers. However the demarcation between amorphous and semicrystalline polymers is not precisely stated and although "amorphous" in its strictest sense would preclude any trace of crystallinity in practice it could never be said with certainty "that a material had no trace of crystallinity whatsoever since this would require a technique with infinite sensitivity to detect crystallinity.

The term "based on" as recited in at least claim 1 is unclear since this term can be construed to mean K is composed solely of C or merely that some C must be present.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuoka et al. (JP 10-025460).

Patentees disclose a block copolymer composition in which one or more block copolymers of formula ABA or BAB (paragraph 13) may be blended and in which the block "A" is a "vinyl system polymer" (paragraph 12) such as inherently high melting and high T<sub>g</sub> polymers such as those derived from styrene or methyl methacrylate may be used (paragraphs 19 and 21) while the "B" block is made up of alkyl(meth)acrylate monomers such as butyl methacrylate with a T<sub>g</sub> of less than zero (Derwent Abstract; paragraphs 23 and 24 of the patent). Since applicants specification discloses that the softening point of amorphous polymers is to be viewed as their T<sub>g</sub>, polymers of the "B" block such as polybutylacrylate would encompass those of applicants "P(B1)" block. Note that molecular weights of the block copolymers are 30,000-1,500,000 at paragraph 14 while the vinyl system polymer is present at a level of 30-50% at paragraph 27. With regard to applicants limitation of a two phase system, polymer miscibility is the exception rather than the rule including for blocks of a block copolymer and multiple phases would be assumed by those skilled in the art.

There are no examples in which all of applicants features are present in combination simultaneously. However to arrive at such by selecting from the various disclosures of the reference would have been obvious to a practitioner

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having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results. With regard applicants ratio in claim 2, the reference discloses no specific ratio and discloses the equivalence of the various block copolymers described and hence substitution of any amount of one of the block copolymers for another would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

Claims 1-12 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peffley et al. (US 6093410).

Patentees disclose a triblock polyethyleoxazoline-polydimethylsiloxane-polyethyloxazoline with each block 3,000 molecular weight such as would be expected to have a liquid polydimethylsiloxane block as in applicants P(B) blocks and have polyoxazoline blocks as in applicants A blocks (see the second table in column 36). Note that the composition may be mixtures of ABA and BAB polymers and hence the patent suggests use of the polymer with the inverse structure ie polydimethylsiloxane-polyoxazoline –polydimethylsiloxane in combination with the triblock polyethyleoxazoline-polydimethylsiloxane-polyethyloxazoline in the second table in column 36. While there are no examples of such combinations to arrive at such would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

Burdon et al. (US 2003/0037857), cited of interest discloses that the glass transition of polyethyloxazoline is 66-72 degrees in paragraph 21.

Claims 1-12 and 15-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kegley (WO 00/12645), cited by applicants.

Patentees disclose a composition containing a combination of ABAD tetrablockcopolymer and ABA triblock copolymer in which the "A" blocks are polyvinylaromatic such as are known in the art to be high melting and "B" and "D" blocks which are polydiene blocks (note page 3, lines 15-35 as well as the first example in the table on page 16; note also applicants molecular weights) such as are known in the art to generally be amorphous and have low glass transitions. The BAD portion of patentees ABAD tetrablock would therefore reasonably appear to read on applicants' component "K2". Note also that the table on page 16 discloses further combination with diblock copolymers

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6703441. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlap (note especially patent claim 4).

Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,067,581. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlap (note especially patent claim 2).

Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,723,407. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlap (note especially patent claim 3).

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/537,469. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlaps (note especially copending claim 2).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.



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Jeffrey C. Mullis  
Primary Examiner  
Art Unit 1796

JCM

5-1-08

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796